

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed December 13, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 102(b)

A. Rejection Under Loudenslager

Claims 1, 22, 32, and 36 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Loudenslager (U.S. Pat. No. 5,828,545). Applicant respectfully traverses this rejection.

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

In the present case, not every feature of the claimed invention is represented in the Loudenslager reference. Applicant discusses the reference and Applicant’s claims in the following.

Loudenslager discloses a computer tower with external support wells for media storage devices. Loudenslager, Patent Title. More particularly, Loudenslager teaches a computer tower that include support wells 36 that receive compact disc *storage cases* 46. Loudenslager, column 2, lines 32-40; Figures 2 and 3.

Loudenslager fails to teach several of Applicant's claims. By way of example, Applicant's claim 1 provides as follows (emphasis added):

1. A *portable electronic device*, comprising:
a *compact disc holder* integrated with an exterior surface of the portable electronic device, the compact disc holder *being adapted to secure a compact disc* on the portable electronic device.

As a first matter, Loudenslager does not teach a "portable electronic device". Clearly, a person having ordinary skill in the art would not consider Loudenslager's "computer tower" to be a portable device. Loudenslager fails to anticipate claim 1 for at least that reason.

Second, Loudenslager does not teach a compact disc holder at all. Instead, as is noted above, Loudenslager only teaches support wells that hold compact disc *storage cases*. That such cases may themselves contain compact discs still does not equate to a teaching of a *compact disc holder*. Specifically, Loudenslager does not state that the support wells are or even could be used to directly hold compact discs. Applicant submits that those support wells are ill suited for such an application.

Finally, in view of the above, Loudenslager's computer tower certainly cannot be considered to comprise a compact disc holder that is "adapted to secure a compact disc". Again, Loudenslager's support wells merely support storage cases. Not only is such "supporting" not "securing" within common parlance, that supporting is performed on the storage cases and not on the compact discs themselves, as is required by Applicant's claim 1.

Regarding independent claims 22 and 32, Applicant refers back to the discussion of the Loundslager disclosure provided above as several aspects of that discussion also apply to claims 22 and 32.

B. Rejections Under Cloran

Claims 1-3, 14, 15, 22, 23, 26, 28, 29, 32, 33, and 36-40 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Cloran, et al. (“Cloran,” U.S. Pat. No. 5,950,822). Applicant respectfully traverses this rejection.

As was noted in the previous Response, Cloran does not teach a compact disc holder that is “integrated with an exterior surface” or “unitarily formed” with “an exterior mounting surface” of a portable electronic device. Instead, Cloran teaches that a compact disc holder can be “attached” to such a surface instead of being integrated into the surface. Cloran, column 4, lines 58-62. Claims 1-3, 14, 15, 22, 23, 26, 28, 29, 32, and 33 are believed to be allowable over Cloran for at least this reason.

In the Office Action, the Examiner argues that attaching Cloran’s compact disc holder to the surface of a component is equivalent to a compact disc holder integrated or unitarily formed with that component. Applicant disagrees. Clearly, as is apparent from Applicant’s disclosure, Applicant’s devices incorporate an integral holder into the design of the device. Cloran does not anticipate such a device. In fact, quite to the contrary, Cloran teaches a separate disc holder that can be attached to nearly any device. Indeed, such flexibility can be considered to be the crux of Cloran’s disclosure.

Applicant has described the above difference by reciting in the claims that the disc holder is “integrated with” or “unitarily formed with” a surface of the device. Use of such

language is intended to express the notion that Applicant's claimed devices are actually formed to include such a holder from the start so that a separate holder, such as Cloran's, is not necessary. Although the Examiner has taken a broad interpretation of the terms "integral" and "unitary" for purposes of the rejection, Applicant asserts that such an interpretation is not warranted in this case. Specifically, it is clear from Applicant's disclosure that Applicant is using those terms to describe an aspect that is clearly not taught by Cloran: producing a device having its own integral disc holder, not later adding a separate holder to the device. As is well established in the law, claim terms must be interpreted in light of the specification. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995)(in banc), *aff'd*, 517 U.S. 370, 38 USPQ2d 1461 (1996) ("Claims must be read in view of the specification, of which they are a part").

For the above reasons, Applicant asserts that Cloran does not anticipate a portable electronic device having a compact disc holder that is "integrated with an exterior surface of the portable device", as is recited in claim 1.

Applicant notes that the above discussion is also relevant to independent claims 15, 22, 29, and 32. With particular regard to claims 15 and 29, Cloran clearly does not teach a portable electronic device having a central opening retainer that is "unitarily formed with the mounting surface" of the device. Applicant asserts that the term "unitary" is normally used in the manufacturing arts to describe components that have actually been *formed together*, as opposed to merely being attached to each other after separate fabrication. As an example, "unitary construction" is often used to describe components that have been unitarily formed together through a molding process (e.g., injection molding). Applicant

respectfully submits, therefore, that the Examiner's dictionary definition of "unitary" of little probative value in interpreting Applicant's claims.

Irrespective of the above, Applicant invites the Examiner to suggest claim language that would, to the Examiner's satisfaction, distinguish Applicant's inventions over those of Cloran. Applicant believes that the Examiner can recognize the clear differences between Applicant's inventions and those of Cloran. Applicant therefore seeks the Examiner's assistance in identifying words that *describe* those differences in a manner that is acceptable to the Examiner.

II. Claim Rejections - 35 U.S.C. § 103(a)

A. Rejection of Claims 1-3, 13-15, 22, 23, 26-29, 32, 33, and 36-40

Claims 1-3, 13-15, 22, 23, 26-29, 32, 33, and 36-40 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Cloran, et al. ("Cloran," U.S. Pat. No. 5,950,822) in view of Wolff (U.S. Pat. No. 5,933,772). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.

As is mentioned above, Cloran does not teach a compact disc holder that is "integrated with an exterior surface" or "unitarily formed" with "an exterior mounting surface" of a portable electronic device. Instead, Cloran teaches that a compact disc holder can be "attached" to such a surface. Cloran, column 4, lines 58-62. Wolff's teaching of a "coin holder" attached to a beeper does not overcome Cloran's teaching of attaching a compact disc holder to another object. First, Cloran explicitly teaches away from an integrated or unitarily-formed holder. In fact, it appears that part of the focus of Cloran's disclosure is that Cloran's holder is separate and therefore can be used on substantially any surface to which the holder can be stuck. Second, as was mentioned in the previous Response, Wolff's teaching is for a coin holder, not a compact disc holder. A person having ordinary skill in the art of the compact disc holders would not look to Wolff's coin holder to modify Cloran's compact disc holder.

B. Rejection of Claims 1-3, 13-15, 22, 23, 26-29, 32, 33, and 36-40

Claims 1-3, 13-15, 22, 23, 26-29, 32, 33, and 36-40 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Cloran in view of Loudenslager. Applicant respectfully traverses this rejection.

As is mentioned above, Cloran does not teach a compact disc holder that is “integrated with an exterior surface” or “unitarily formed” with “an exterior mounting surface” of a portable electronic device. Instead, Cloran teaches that a compact disc holder can be “attached” to such a surface. Cloran, column 4, lines 58-62. Loudenslager’s teaching of storage case support wells provided on a computer tower does not overcome Cloran’s teaching of a separate compact disc holder that can be attached to nearly any object. First, Cloran explicitly teaches away from an integrated or unitarily-formed holder for reasons described above. Second, Loudenslager’s teaching is for *storage case* holder, not a compact disc holder. Given that fact, a person having ordinary skill in the art would not look to Loudenslager’s storage case holder for ideas as to how to modify Cloran’s compact disc holder.

C. Rejection of Claims 4 and 16

Claims 4 and 16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over “the references as applied to claims 2 and 15 above” and further in view of Cerda-Vilaplana et al. (“Cerda-Vilaplana,” U.S. Pat. No. 5,933,772) or Sommi (U.S. Pat. No. 5,570,791). Applicant respectfully traverses this rejection.

As a first matter, Applicant respectfully submits that the rejection is improper for vagueness. Specifically, it is unclear what “the references as applied to claims 2 and 15

above” are. Is the Examiner speaking of Cloran alone under the section 102 rejection? Or is the Examiner speaking of Cloran alone under the section 103 rejection? Or is the Examiner speaking of Cloran in view of Wolff under the section 103 rejection? Or is the Examiner speaking of Cloran in view of Loudenslager under the section 103 rejection?

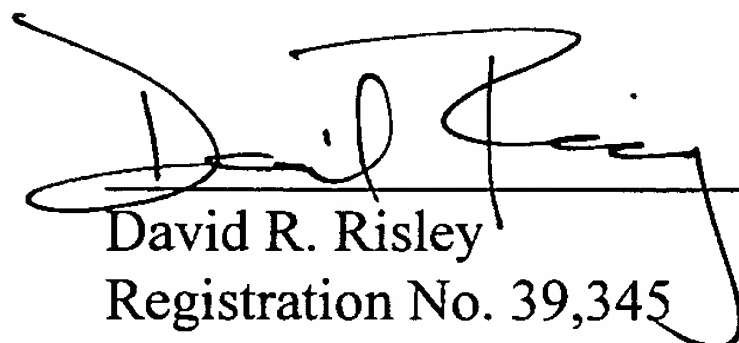
Given that Applicant cannot determine what the rejection against claims 4 and 16 is, Applicant submits that the rejection is improper and should be withdrawn in favor of a clear rejection presented in a non-final Office Action. Without such a rejection and a non-final Office Action, Applicant will be denied a full and fair opportunity to address the rejections that have been made against Applicant’s claims.

As a further point, Applicant notes that in that neither Cerda-Vilaplana nor Sommi remedy the deficiencies of any of the Cloran, Wolff, and Loudenslager references described in the foregoing, Applicant submits that claims 4 and 16, which depend from claims 1 and 15, respectively, are allowable for at least the same reasons that claims 1 and 15 are allowable.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


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